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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,772	09/17/2003	Richard I. Masel	1201.68148	4868

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EXAMINER

YUAN, DAH WEI D

ART UNIT	PAPER NUMBER
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1745

MAIL DATE	DELIVERY MODE
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01/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/664,772

Applicant(s)

MASEL ET AL.

Examiner

Dah-Wei D. Yuan

Art Unit

1745

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 December 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 17-19,21-23 and 51-57.
Claim(s) withdrawn from consideration: 58-63.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

Continuation of 11. does NOT place the application in condition for allowance because: Applicants argue that new claims 58-63 are closely related to species I-2, claims 17-19,21-23,51-57. Claims to be restricted to different species must be mutually exclusive. See MPEP 806.04(f). Independent claim 17 recites "[a] passive direct organic fuel cell comprising an anode enclosure having a gas remover comprising a plurality of passages that are configured to allow passage of CO₂ from the enclosure while substantially preventing passage of the organic fuel solution". Independent claim 58 recites "[an] organic fuel cell comprising a gas remover comprising at least 5 passages penetrating at least one of the plurality walls". Independent claim 62 recites "[an] organic fuel cell comprising passages having an entrance that is separated from the at least one wall by distance whereby the entrance extends into the anode enclosure". The claims are restricted to different species, respectively, is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. Therefore, the restriction requirement is still deemed proper and is therefore made FINAL.

Applicants argue that new and unexpected results that are not disclosed or suggested by Beckmann reference. The instant disclosure only teaches the gas remover is useful to cause the gas to flow through the fuel solution held in the chamber sufficiently to provide useful circulation of the solution. However, the Applicant has not established the differences in results that are in fact unexpected and unobvious and of both statistical and practical significance. The burden is on Applicant to establish results that are unexpected and significant. See MPEP 716.02(a) and (b).

The recitation "passive" in claim 17 is given its broadest reasonable interpretation. Also, applicant is reminded that limitations appearing in the specification but not recited in the claim are not read into the claim. See *In re Zletz*, 893F.2d 319,321-22,13 USPQ2d, 1320, 1322 (fed. Cir. 1989). Applicant is asked to further define the term "passive direct organic fuel cell" in the claim to distinguish over the prior arts. Applicant further argues that Ha reference is not a prior art for portion of claim 19. The exclusion in 103(c) only applies to prior art that is used in an obviousness rejection under 103(a) based on a reference that only qualifies as prior art under 102(e), (f) or (g). The Ha reference published in the Journal of Power Sources, which would have been qualified as a prior art under 102(a). Therefore, claim rejections on 18,19 under 35 U.S.C. 103(a) as being unpatentable over Davis and Beckmann et al and further in view of Ha et al. are proper and thus maintained.



DAH-WEIYUAN
PRIMARY EXAMINER